



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.       | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------------|------------------|
| 10/552,410  | 10/07/2005  | Takehito Nakayama    | 1217-052834               | 2397             |
| 28289   | 7590        | 02/05/2007           | EXAMINER                  |                  |
| THE WEBB LAW FIRM, P.C.<br>700 KOPPERS BUILDING<br>436 SEVENTH AVENUE<br>PITTSBURGH, PA 15219 |             |                      | MCCLELLAND, KIMBERLY KEIL |                  |
|   |             | ART UNIT             |                           | PAPER NUMBER     |
|   |             |                      |                           | 1734             |
| SHORTENED STATUTORY PERIOD OF RESPONSE  |             | MAIL DATE            | DELIVERY MODE             |                  |
| 31 DAYS   |             | 02/05/2007           | PAPER                     |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

|                        |                    |  |
|------------------------|--------------------|--|
| Application No.        | NAKAYAMA, TAKEHITO |  |
| Examiner               | Art Unit           |  |
| Kimberly K. McClelland | 1734               |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1) Responsive to communication(s) filed on 23 August 2006.  
2a) This action is FINAL. 2b) This action is non-final.  
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

4) Claim(s) 1-27 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) Claim(s) \_\_\_\_\_ is/are allowed.  
6) Claim(s) \_\_\_\_\_ is/are rejected.  
7) Claim(s) \_\_\_\_\_ is/are objected to.  
8) Claim(s) 1-27 are subject to restriction and/or election requirement.

### Application Papers

9) The specification is objected to by the Examiner.  
10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

1) Notice of References Cited (PTO-892)  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) Notice of Informal Patent Application  
6) Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claims(s) 1-7 and 14-21, drawn to a method for sticking tape.

Group II, claim(s) 8-11, 13, and 22-26, drawn to an apparatus for sticking tape.

Group III, claim(s) 12 and 27, drawn to an apparatus for sticking tape.

2. The inventions listed as Groups I-III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

3. Group I, claims 1-7 and 14-21 contain no special technical feature. Japanese Patent Application Publication No. JP6100842 to Kazu discloses every claim limitation as set forth in independent claim 1, including preparing the tape for sticking to the adherend, wherein said tape has a sticky surface and all opposed non-sticky surface (i.e. pressure-sensitive adhesive layer); attaching the tape via the non-sticky surface to a support film having a removable sticky surface (i.e. carrier), wherein the removable sticky surface of the support film contacts the non-sticky surface of the tape (See Figure 1a); while subjecting the support film to tension, causing the sticky surface of the tape on the support film to be opposed to a surface of the adherend mounted on a mounting table (See Figure 1b); sticking the tape to the adherend by pressing the support film; and releasing the support film from the tape (See Figure 1c). Consequently, no special technical feature is present in Group I.

4. Group II, claims 8-11, 13, and 22-26 contain no special technical feature. U.S. Patent Application No. 6,709,541 to Stone discloses every claim limitation as set forth in independent claim 1, including a mounting table (12) on which the adherend (76) is mounted (74); a frame member (14) provided to include an adherend-mounting surface of the mounting table (12); a fixing roll (68) for attaching and fixing a long support film (18) to the frame member, the support film having a sticky and removable surface to

which the tape(74) is attached; and a sticking roll (48) for sticking the tape (74) to the adherend (76); the apparatus being constructed such that: the support film (18) is arranged above the frame member (12) so that the tape is included in a frame of the frame member; the fixing roll (68) is caused to press the support film to fix the support film (18) to the frame member (12); the sticking roll (48) is caused to press the support film in the frame of the frame member to stick the tape to the adherend (76); and the support film is released from the tape (See Figures 6a-6e). Consequently, no special technical feature is present in Group II.

5. Group II, claims 12 and 27 contain no special technical feature. U.S. Patent Application No. 6,709,541 to Stone discloses every claim limitation as set forth in independent claim 1, including a mounting table (12) on which the adherend (76) is mounted; a press roll (48) for pressing a long support film (18) having a sticky and removable surface to which the tape (74) is attached, to stick the tape (74) to the adherend (76); and a clamping member(38a) for clamping the support film across a width of said support film (See Figure 1a); the apparatus being constructed such that: the support film (18) is clamped at longer edge portions thereof with the clamping member and the clamping member is moved to cause the sticky surface of the tape on the support film to be opposed to a surface of the adherend (76) mounted on the mounting table (12); the press roll (48) is caused to press the support film to stick the tape (74) to the adherend (76); and the support film (18) is released from the tape (74) by relatively moving the clamping member (38; See Figures 6a-6e). Consequently, no special technical feature is present in Group III.

6. No special technical feature was found in any of the preceding groups. As a result, no two groups contain a corresponding special technical feature and a lack of unity exists.

7. A telephone call was made to Mr. Kent Baldauf on January 19th to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly K. McClelland whose telephone number is (571) 272-2372. The examiner can normally be reached on 8:00 a.m.-5 p.m. Mon-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris A. Fiorilla can be reached on (571)272-1187. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*Kim McCullard*

KKM

*[Handwritten Signature]*